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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,270	03/17/2005	Stephen John Brough	06275-451US1	4129
26164 7590 11/12/2008 FISH & RICHARDSON P.C. P.O BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER MOORE, SUSANNA				
ART UNIT		PAPER NUMBER		
1624				
NOTIFICATION DATE		DELIVERY MODE		
11/12/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

### Office Action Summary

**Application No.**

10/528,270

**Applicant(s)**

BROUGH ET AL.

**Examiner**

SUSANNA MOORE

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,9 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,9 and 19 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CI/CC)  
Paper No(s)/Mail Date 8/29/08, 8/29/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/29/2008 has been entered.

### ***Response to Arguments***

Applicant's argument, see Remarks, filed 9/11/2008, with respect to the rejection(s) of claim(s) 1, 9 and 19 have been fully considered. Since claims 1, 9 and 19 are in condition for allowance, prosecution is now closed. **This is a Quayle Action due to the objection of the Specification.**

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 8/29/2008 was filed after the mailing date of the RCE (request for continued examination) on 8/29/2008. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Specification***

The disclosure is objected to because of the following informalities: the Specification should be written as outlined below.

Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

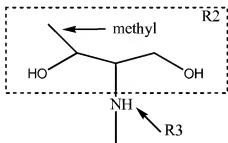
As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

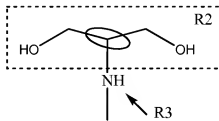
### ***Claim Rejections - 35 USC § 103***

The rejection of claims 1 and 9 under 35 U.S.C. 103(a) as being obvious over Willis et. al. (WO 01/25242, US equivalent is 6790850) is **withdrawn** based on the Remarks and declaration submitted by Thomas McNally. The declaration compares the following compounds, 5-[[[(2,3-difluorophenyl)methyl]thio]-7-[[2-hydroxy-1-

(hydroxymethyl)propyl]amino]thiazolo[4,5-d]pyrimidin-2(3H)-one and 5-[[[(2,3-difluorophenyl)methyl]thio]-7-[[2-hydroxy-1-(hydroxymethyl)ethyl]amino]thiazolo[4,5-d]pyrimidin-2(3H)-one, which differ solely by a methyl substituent as illustrated below.



R2 and R3 with attached nitrogen of the current case



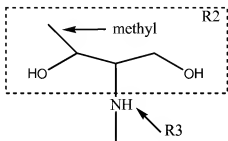
R2 and R3 with the attached nitrogen of the co-pending case

The provisional rejection of claims 1 and 9 under 35 U.S.C. 103(a) as being obvious over copending Application No. 10863995 which has a common assignee with the instant application is **withdrawn** since this case is a related case with the same disclosure as the '850 patent cited above.

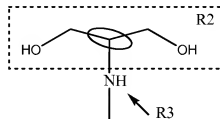
#### ***Double Patenting***

The rejection of claims 1 and 9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,790,850 is **withdrawn** based on the Remarks and declaration submitted by Thomas McNally. The declaration compares the following compounds, 5-[[[(2,3-difluorophenyl)methyl]thio]-7-[[2-hydroxy-1-(hydroxymethyl)propyl]amino]thiazolo[4,5-d]pyrimidin-2(3H)-one and 5-[[[(2,3-

difluorophenyl)methyl]thio]-7-[[2-hydroxy-1-(hydroxymethyl)ethyl]amino]thiazolo[4,5-d]pyrimidin-2(3H)-one, which differ solely by a methyl substituent as illustrated below.



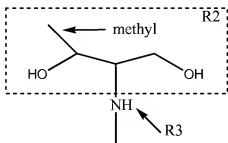
R2 and R3 with attached nitrogen of the current case



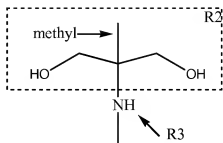
R2 and R3 with the attached nitrogen of the co-pending case

The rejection of claims 1 and 9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20-26 of copending Application No. 10/863995 is **withdrawn** based on the Remarks and declaration submitted by Thomas McNally.

The rejection of claims 1 and 9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 9 of copending Application No. 10/528316 is **withdrawn** based on the Remarks and declaration submitted by Thomas McNally. The declaration compares the following compounds, 5-[[[(2,3-difluorophenyl)methyl]thio]-7-[1,1-(di(hydroxymethyl))ethyl]amino]thiazolo [4,5-d]pyrimidin-2(3H)-one and the claimed non-salt compound. These compounds are positional isomers as illustrated below.



R2 and R3 with attached nitrogen of the current case



R2 and R3 with the attached nitrogen of the co-pending case

See the declaration in the 10528316 application for data for the non-salt compound to which this compound was compared, page 14, example 1.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSANNA MOORE whose telephone number is (571)272-9046. The examiner can normally be reached on M-F 8:00-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna Moore/  
Examiner, Art Unit 1624

/Brenda L. Coleman/  
Primary Examiner, Art Unit 1624